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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/138,926	08/24/1998	FRANK C. CESARE	D-6362	4707
6449	7590	03/30/2005		
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			EXAMINER RAYFORD, SANDRA M	
			ART UNIT 1772	PAPER NUMBER

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/138,926	CESARE	
	Examiner	Art Unit	
	Sandra M. Nolan	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-28,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-28 and 30-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

✓

DETAILED ACTION

Claims

1. Claims 14-28 and 30-31 are now pending.

Claims 1-13 and 29 have been cancelled.

Claim 31 is new.

Amendment

2. The 28 February 2005 amendment ("the last response") in this application was submitted in reply to the 09 December 2004 office action ("the last office action").

Summary of Base Claim

3. The sole base claim of the application is claim 14, which is summarized as follows:

Claim 14 covers a composition comprising:

a) a polymer formed from 67-75% ethylene, 15 to 50% of a C₂-C₉ alpha-olefin and 0 to 30% of a non-conjugated diene [with a total of 100% for all monomers],
said polymer:

i) having a viscosity average molecular weight (MW) of 4,000 to 30,000

ii) being solid at room temperature;

b) a reinforcing agent; and

c) a high MW polymer.

Rejections Maintained

4. The 35 USC 102 rejection of claims 14, 21-23 and 27 is maintained for reasons of record.

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5. The obviousness-type double patenting rejection of claims 14-28 and 30 is modified to cover claims 14-28 and 30-31 and is maintained for reasons of record.

Response to Arguments

6. Applicant's arguments filed in the last response have been fully considered but they are not persuasive.

On pages 7-8 of the arguments, applicant refers to the prosecution of this application and note that the outstanding office action was non-final.

However, this action is a *final* rejection. See below.

On pages 8-9, applicant argues that Liu cannot anticipate the instant claims because it does not teach the molecular weight limitation of those claims.

However, the Liu copolymers are solids (note col. 9, lines 3 and 26, where "dry blending" and "melting" of same are recited) and they are made of the same amounts and types of monomers that applicant claims (see col. 5, lines 25-30 and 37-42, where comonomer contents of up to 20 mole% and propylene comonomer are taught.).

In the absence of objective evidence to the contrary, the fact that the same monomers and amounts are employed to make the Liu copolymers means must have the same molecular weights as applicant's copolymers. See the discussion of inherency at MPEP 2112.01.

Note: On page 8 of the last response, in the last two lines, applicant argues that claim 14 recites ethylene/propylene copolymers. It does not. Claim 14 recites the co- and terpolymers set out in the summary above; it is not limited to ethylene and propylene comonomers in ingredient a).

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On page 9 applicant argues that the obviousness-type double patenting rejection is improper because claim 14 of this case recites "solid" ethylene/propylene copolymers, while Cesare claims liquid copolymers.

However, claim 14 does not recite ethylene/propylene copolymers. See the note above.

Also, applicant has presented to objective evidence showing that the use of solid dispersion aids produces unexpected results when compared to the use of liquid ones.

On page 10, applicant argues that there is no motivation to use liquid dispersants.

However, as Liu points out at col. 9, line 26, melting is often used to blend these types of polymers with other polymers. A skilled artisan at the time of the invention would have presumed that the heat and other processing parameters associated with melting solid dispersants could be avoided if liquid dispersants were used.

On page 11, applicant argues that claims 1 and 7 of the Cesare (or '128) patent are silent regarding the amounts of comonomers present in its copolymers, so that those claims "cannot be viewed as suggesting the presently-claimed proportions".

However, the amounts of comonomers used in this application are deemed obvious because the claimed amounts have not been demonstrated to yield copolymers that give unexpected results when compared to those in the Cesare '128 compositions.

Final Rejection

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can be reached Monday through Thursday, from 6:30 am to 4:00 pm, ET.

If attempts to reach the examiner are unsuccessful, contact her supervisor, Harold Pyon, at 571/272-1498.

The fax number for patent application documents is 703/872-9306.


S. M. Nolan-Rayford
Primary Examiner
Technology Center 1700

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